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**UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office**

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cn

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. |
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|-----------------|-------------|----------------------|---------------------|

09/392,270 09/09/99 POIRIER

J 1-21036

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| EXAMINER |
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027210 QM32/0727
MACMILLAN, SOBANSKI & TODD, LLC
ONE MARITIME PLAZA - FOURTH FLOOR
720 WATER STREET
TOLEDO OH 43604

| | |
|-----------|--------------|
| NGUYEN, T | |
| ART UNIT | PAPER NUMBER |

3726
DATE MAILED:

07/27/01

14

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
09/392,270

Applicant(s)
Poirier et al.

Examiner
Trinh Nguyen

Art Unit
3726



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Jul 12, 2001
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above, claim(s) 8-14 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7, 15, 16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- *See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- 15) ☒ Notice of References Cited (PTO-892) 18) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 19) ☐ Notice of Informal Patent Application (PTO-152)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____ 20) ☐ Other:

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DETAILED ACTION

Double Patenting

1. Claims 1-7, 15, and 16 are directed to an invention not patentably distinct from claims 11-20 of commonly assigned 09/408,747. Specifically, the subject matters in the instant application are claimed as method claims as similar to the claims of the cited application and the differences, i.e., deleting and/or adding subject matters, therebetween would have been obvious.
2. Commonly assigned 09/408,747, discussed above, would form the basis for a rejection of the noted claims under 35 U.S.C. 103(a) if the commonly assigned case qualifies as prior art under 35 U.S.C. 102(f) or (g) and the conflicting inventions were not commonly owned at the time the invention in this application was made. In order for the examiner to resolve this issue, the assignee is required under 37 CFR 1.78[©] and 35 U.S.C. 132 to either show that the conflicting inventions were commonly owned at the time the invention in this application was made or to name the prior inventor of the conflicting subject matter. Failure to comply with this requirement will result in a holding of abandonment of the application.

A showing that the inventions were commonly owned at the time the invention in this application was made will preclude a rejection under 35 U.S.C. 103(a) based upon the commonly assigned case as a reference under 35 U.S.C. 102(f) or (g).

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible

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harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321[©] may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

4. Claims 1-7, 15, and 16 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 11-20 of copending Application No. 09/408,747. Although the conflicting claims are not identical, they are not patentably distinct from each other because the subject matters in the instant application are claimed as method claims as similar to the claims of the cited application and the differences, i.e., deleting and/or adding subject matters, therebetween would have been obvious.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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6. **Claims 1-7, 15, and 16** are rejected under 35 U.S.C. 103(a) as being unpatentable over **Applicant's Admitted Prior Art** (as set forth in lines 13-29 of page 1, all of pages 2 & 3, lines 1-10 of page 4, lines 19-24 of page 6, lines 1-22 of page 7, lines 16-26 of page 8, and lines 22-25 of page 9; hereinafter is referred to as **AAPA**).

AAPA discloses that it is old and well known to manufacture a vehicle frame structure by: providing a closed channel workpiece member; performing a heat treatment process to softening the workpiece member; and deforming the workpiece member to form a vehicle frame structure. Further note that the use of inductive heating coil and quenching ring are well known and conventional as admitted by the Applicants in lines 18 & 19 of page 8 and line 23 of page 9. **AAPA** teaches the claimed invention except to mention that when performing the heat treatment process on the workpiece the inductive heating coil and the quenching ring are moved in a continuous and longitudinal manner from one end of the workpiece to the other end. However, an **Official Notice** is taken that the concept of heat treating a workpiece with a device, in this case an inductive heating coil and a quenching ring, either in a stationary manner or in a continuous manner relative to the workpiece is notoriously old and well known throughout the art, in order to easily and economically deform a workpiece member due to its low and/or high threshold temperatures.

Regarding claims 4-7, **AAPA** sets forth the invention as cited above with the exception of the orientation of the workpiece. It would have been obvious to one of ordinary skill in the art at the time the invention was made that whether the heat treatment process is performed by

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suspending and/or supporting the workpiece member vertically or horizontally by an upper end and/or lower end is a matter of design choice since no significant problem is solved or unexpected result obtained by supporting the members in the orientation claimed versus that taught by the prior art.

It is noted that the Applicants recite specific article design limitations in claims 15 and 16, i.e., specific material limitations, however, such limitations must result in a manipulative difference in the recited process steps as compared to the prior art. In this instance these design limitations are held to be obvious and not given patentable weight in these method of manufacturing claims as such limitation(s) do not result in any difference in the *claimed* manufacturing process.

Response to Arguments

7. Applicant's arguments filed 7/12/01 have been fully considered but they are not persuasive.

8. Since Applicants have challenged the Official Notice, reference Mills et al. (US 4,362,578) which disclose a method of heat treating a metal workpiece (a vehicle frame component can be interpreted as a metal workpiece) by using a induction heating coil to heat the workpiece by either having the workpiece moves through (or "in a continuous manner relative to") the coil or having the coil moves through (or "in a continuous manner relative to") the workpiece (see lines 3-8 of col. 3), have been cited, which for purposes of appeal may be treated as having been substitute for the Official Notice taken herein.

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Conclusion

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure and are cited on form PTO-892 encloses herewith.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Trinh Nguyen** whose telephone number is **(703) 306-9082**.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-1148.

J. C. Allen
Art 3726

ttn

July 23, 2001